



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,055	02/03/2004	Reinhard Heinrich Hohensee	15962.0006USD1/IBMN.004US	1532
23552	7590	09/27/2010	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				KIM, PAUL
ART UNIT		PAPER NUMBER		
2169				
MAIL DATE		DELIVERY MODE		
09/27/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/771,055	HOHENSEE ET AL.	
	Examiner	Art Unit	
	PAUL KIM	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 July 2010.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,5-7,9-11,13-17 and 26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,5-7,9-11,13-17 and 26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This Office action is responsive to the following communication: Request for Continued Examination filed on 26 July 2010.
2. Claims 1, 5-7, 9-11, 13-17, and 26 are pending and present for examination.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 July 2010 has been entered.

Response to Amendment

4. Claims 1, 15, and 26 have been amended.
5. Claims 8 and 12 have been cancelled.
6. No claims have been added.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. **Claims 1 and 26** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s),

Art Unit: 2169

at the time the application was filed, had possession of the claimed invention. Applicant's newly presented amendment provides the recited limitation of "caching the object only for a duration of the presentation job when the selected indicia is identified to not include a globally-unique network identifier." The instant Specification fails to support for the feature of caching an object when the selected indicia is identified to not include a globally-unique network identifier. Applicant is directed to provide the portion of the Specification which would reasonably provide one skilled in the relevant art that the inventor(s) had possession of the claimed limitation.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1 and 26** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's newly presented amendment provides the recited limitation of "caching the object only for a duration of the presentation job when the selected indicia is identified to not include a globally-unique network identifier." The Examiner notes though that a previous limitation of the instant claim recites the feature of "referencing an object stored on a network for executing a presentation job at a presentation device using a selected indicia defining a location of the object in the network, the selected indicia being a globally-unique network identifier or a globally-unique network identifier and an object locator." Accordingly, it is noted that the selected indicia is to include a globally unique network identifier. Wherein the newly recited limitation recites that "the selected indicia is identified to not include a globally-unique network identifier," it would be unclear to one skilled in the relevant art as to when an object would be cached. That is, the instant claim, while reciting that the selected indicia is to include a globally-unique network identifier, reverses itself by claiming that the selected indicia may not necessarily include a globally-unique identifier. Further clarification is necessary in order to particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1, 5-7, 9-11, 13-17, and 26** are rejected under 35 U.S.C. 102(b) as being anticipated by Shorter, U.S. Patent No. 6,687,707, filed on 28 November 1997, and issued on 3 February 2004.

13. **As per independent claims 1 and 26,** Shorter teaches:

A method for processing referenced objects, comprising:

referencing an object stored on a network for executing a presentation job at a presentation device using a selected indicia defining a location of the object in the network, the selected indicia being a globally-unique network identifier or a globally-unique network identifier and an object locator {See Shorter, C5:L34-47, wherein this reads over "an object identifier for uniquely identifying object within a plurality of data processing system networks"};

searching for the object at the location on the network defined by the selected indicia {See Shorter, C7:L1-9, wherein this reads over "the unique object identifier for the object is contained within the object attribute records"; and "the attributes in the object attribute record may be utilized to determine the object identifier so that the object may be retrieved from the database"};

downloading the object to the presentation device from the location on the network defined by the selected indicia {See Shorter, C5:L47-65, wherein this reads over "the next ordered field 404 contains a unique value for the data processing system within the network in which the identified object is contained. The low order field 4-6 contains a unique value for the object within the host data processing system in which the identified object may be found"; and C7:L5-9, wherein this reads over "the object may be retrieved from the database"};

analyzing the downloaded object at the presentation device to identify the selected indicia of the downloaded object {See Shorter, C12:L61-67, wherein this reads over "locating an object identifier to retrieve the identified object for modification, which may also require modification of the associated object attribute record"};

capturing the object in persistent memory of the presentation device only when the selected indicia is identified to include a globally-unique network identifier {See Shorter, C7:L5-9, wherein this reads over "the attributes in the object attribute record may be utilized to determine the object identifier so that the object may be retrieved from the database"}; and

caching the object only for a duration of the presentation job when the selected indicia is identified to not include a globally-unique network identifier.

Art Unit: 2169

The Examiner notes that prior art has not been applied to the newly recited claim limitations in that they fail to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Furthermore, wherein the newly recited claim limitations present a situation wherein the invention would not be enabled, the Examiner notes that further clarification is needed as noted in the related rejections made under 35 U.S.C. 112.

14. **As per dependent claims 3-17**, wherein the independent claim optionally recites "a globally-unique identifier" and "a globally-unique identifier and an object locator" and the present claims recite an object that is referenced with said identifiers, the claims will not be further considered nor will prior art be applied.

Response to Arguments

15. Applicant's arguments with respect to claim rejections under 35 U.S.C. 103 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL KIM whose telephone number is (571)272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2169

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Kim/

Paul Kim
Examiner, Art Unit 2169

/PK/